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PATENT AND TRADEMARK OFFICE**

APPLICANTS/
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EXAMINER: Christopher R. Buchanan

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Dated: February 5, 2009 By: /Rajiv P. Patel/
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SUPPLEMENTAL REPLY BRIEF UNDER 37 C.F.R. § 41.41
(IN RESPONSE TO SECOND SUPPLEMENTAL EXAMINER'S ANSWER)

This supplemental reply brief is in response to the second Supplemental Examiner's Answer filed on December 9, 2008.

By way of background, a final Office Action was mailed on December 29, 2005. A Notice of Appeal was filed on March 6, 2006. An Appeal Brief was filed on August 1, 2006. An Examiner's Answer was mailed on October 12, 2007 and a Supplemental Examiner's Answer was mailed on December 5, 2007. A Reply Brief was filed on December 10, 2007 and a Supplemental Reply Brief (in response to the Supplemental Examiner's Answer) was filed

December 21, 2007. A second Supplemental Examiner's Answer with new grounds for rejection was filed on December 9, 2008. The second Supplemental Examiner's Answer contains a new ground of rejection. Appellant hereby requests that the appeal be maintained and files this Supplemental Reply Brief in accordance with 37 C.F.R. § 41.41 in response to the new ground of rejection set forth in the second Supplemental Examiner's Answer.

STATUS OF CLAIMS

Claims 1-37 and 39-47 stand finally rejected in a final Office Action mailed December 29, 2006. Claim 38 was cancelled in an amendment filed under 37 C.F.R. § 41.33 on December 10, 2007. Appellants appeal from the final rejection of claims 1-17 and 39-47, which are set forth in an appendix attached hereto.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The specific grounds of rejection to be reviewed on appeal are as follows:

The Examiner rejected claims 1-26, 36-38, and 41-43 under 35 U.S.C. § 103(a) over a combination of U.S. Patent No. 6,026,376 to Kenney (“Kenney”) and U.S. Patent No. 5,909,023 to Ono et al. (“Ono”). The Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over a combination of Kenney, Ono, and U.S. Patent No. 5,655,174 to Hirst (“Hirst”).

The obviousness rejections are improper because the combination of the cited references does not disclose *a prima facie* basis for obviousness with respect to the rejection of the claimed invention. The Appeal Brief filed August 1, 2006 and the Reply Brief filed December 21, 2007 address these obviousness rejections and will not be repeated in this Supplemental Reply Brief.

The second Supplemental Examiner’s Answer, which was mailed on December 9, 2008, included new grounds of rejection. First, claims 1-14, 27-30, and 39-44 are now rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Second, claims 27-35 and 45-47 are now addressed as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Ono and Hirst.

With respect to the first new grounds for rejection, the grounds for rejection to be reviewed on appeal is whether the statutory subject matter rejection should be removed as improper in view of the claimed subject matter. This Supplemental Reply Brief further addresses this improper statutory subject matter rejection.

With respect to the second new grounds for rejection, the grounds for rejection to be reviewed on appeal is whether the obviousness rejection should be removed as improper because a *prima facie* case of obviousness has not been established. This Supplemental Reply Brief further addresses this improper obviousness rejection.

ARGUMENT IN REPLY TO SECOND SUPPLEMENTAL EXAMINER'S ANSWER

A. Claims 1-14, 27-30, and 39-44 Recite Statutory Subject Matter

The Examiner rejected claims 1-14, 27-30, and 39-44 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The rejection is improper because the claims recite statutory subject matter.

On May 15, 2008, the USPTO Deputy Commissioner for Patent Examination Policy (John J. Love) issued a memorandum entitled “Clarification of ‘Processes’ under 35 USC § 101” (“May 2008 Memo”). The May 2008 Memo stated that “a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.”

On December 9, 2008, the second Supplemental Examiner’s Answer was mailed. The Examiner stated that, in order for a process to be statutory under 35 U.S.C. § 101, the process must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform

underlying subject matter (such as an article or material) to a different state or thing. (Second Examiner's Answer, page 5). Although the Examiner's statement uses slightly different wording, it essentially follows the guidance provided by the May 2008 Memo.

On January 7, 2009, the USPTO Deputy Commissioner for Patent Examination Policy (John J. Love) issued a memorandum entitled "Guidance for Examining Process Claims in view of *In re Bilski*" ("January 2009 Memo"). In *Bilski*, which was decided October 30, 2008, the Court of Appeals for the Federal Circuit ("Federal Circuit") affirmed a Board of Patent Appeals and Interferences ("BPAI") decision sustaining a rejection of claims under 35 U.S.C. § 101. The January 2009 Memo stated (emphasis in the original):

As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine-or-transformation test". It should be noted that the machine-or-transformation test from *Bilski* is slightly different from the test explained in the May 15 Clarification memo, which was based on the Office's interpretation of the law prior to *Bilski*.

The January 2009 Memo does not address the details of the machine-or-transformation test. In particular, the January 2009 Memo does not address "what sorts of things constitute 'articles' such that their transformation is sufficient to impart patent-eligibility under § 101." (*See In re Bilski*, pp. 24-25).

However, the *Bilski* decision does address this topic. Specifically, page 25, *Bilski* states:

The raw materials of many information-age processes, however, are electronic signals and electronically-manipulated data. . . . Which, if any, of these processes qualify as a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter?

Bilski uses *In re Abele*, 684 F.2d 902 (CCPA 1982), to demonstrate when a process qualifies (and when a process does not qualify) as a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter. (*Bilski* at 25-26).

Regarding a claim that did qualify as patent-eligible subject matter, *Bilski* states that the “data [recited in the claim] clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data . . . was sufficient to render that more narrowly-claimed process patent-eligible.” (*Bilski* at 26).

Bilski also notes that “the electronic transformation of the data itself . . . was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.” (Emphasis added); (*Bilski* at 26).

Returning now to the present appeal, independent claim 1 recites:

A method in a data processing system for automatically initiating the replenishment of a consumable product, comprising:

on a first date, fulfilling an order by a consumer for a first instance of the product;

based upon the first date, estimating a second date by which the first instance of the product will be fully consumed;

before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action;

receiving an indication that the control was used by the consumer to request replenishment of the product; and

in response solely to receiving the indication, ordering a second instance of the product to replenish the first instance.

Here, claim 1 recites statutory subject matter under 35 U.S.C. § 101 based on the analysis provided by the January 2009 Memo and the *Bilski* decision. Specifically, the claim recites a physical and tangible object, specifically, a product. Information corresponding to this product, which is a first date and a second date to estimate when the produce will be consumed, provides a transformation that triggers an action. This action includes providing an indication before the second date that the first item should be replenished. More particularly, the indication includes a control, which when used by the consumer, provides a further transformation to place an order to replenish the product. Accordingly, this claim is patent-eligible under the second prong of *Bilski*'s machine-or-transformation test. Hence, it is respectfully requested that the Board reverse the rejection of claim 1.

Next, independent claim 2 recites:

A method in a data processing system for ordering an item, comprising:
on a first date, fulfilling an order by a consumer for a first item;
determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item;
on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item;
receiving an indication that the control was used by the consumer to request replenishment of the first item; and
in response solely to receiving the indication, ordering a second item to replenish the first item.

As with claim 1, claim 2 also recites statutory subject matter under 35 U.S.C. § 101 based

on the analysis provided by the January 2009 Memo and the *Bilski* decision. In particular, this claim also recites a physical and tangible object, specifically, a first item. Information corresponding to this first item, which is a target date for replenishment, provides a transformation that triggers an action. This action includes providing an indication that the first item should be replenished. More particularly, the indication includes a user interface control, which when used by the consumer, provides a further transformation to place an order to replenish the first item. Accordingly, this claim is patent-eligible under the second prong of *Bilski*'s machine-or-transformation test. Hence, it is respectfully requested that the Board reverse the rejection of claim 2.

Likewise, claim 44, which depends from claim 1, and claims 3-14, which depend from claim 2, also recites statutory subject matter for at least the same reasons as claims 1 and 2. Hence, it is respectfully requested that the Board reverse the rejection of these claims.

Referring next to independent claim 27, it recites:

A method in a data processing system for assessing item replenishment, comprising:
determining that a purchasing entity possesses an item;
determining an expiration time for the item; and
scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.

Claim 27 recites statutory subject matter under 35 U.S.C. § 101 based on the analysis provided by the January 2009 Memo and the *Bilski* decision. This claim recites a physical and tangible object, specifically an item. Information corresponding to this item, which is an

expiration time for the item, provides a transformation that triggers an action. This action includes scheduling, prior to the expiration time, a unilateral transmission of a communication to a purchasing entity to replenish the specified item. Accordingly, this claim is patent-eligible under the second prong of *Bilski*'s machine-or-transformation test. Hence, it is respectfully requested that the Board reverse the rejection of claim 27.

Likewise, claims 28-29, which depend from claim 27, also recite statutory subject matter for at least the same reasons as claim 27. Therefore, it is respectfully requested that the Board reverse the rejection of these claims.

Continuing on, independent claim 39 recites:

A method in a computer system for automatically replenishing an item, comprising
determining that a consumer is using an item;
determining a target date for replenishing the item; and
without intervention by the consumer, placing an order on the consumer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date.

Claim 39 recites statutory subject matter under 35 U.S.C. § 101 based on the analysis provided by the January 2009 Memo and the *Bilski* decision. This claim recites a physical and tangible object, namely, an item. Information corresponding to this item, which is a target date for replenishing the item, provides a transformation that triggers an action. This action includes placing an order to replenish the specified item within a particular time period without intervention by the consumer. Accordingly, this claim is patent-eligible under the second prong of *Bilski*'s machine-or-transformation test. Hence, it is respectfully requested that the Board

reverse the rejection of claim 39.

Similarly, claim 40, which depends from claim 39, also recites statutory subject matter for at least the same reasons as claim 39. Therefore, it is respectfully requested that the Board reverse the rejection of claim 40.

Finally, independent claim 41 recites:

A method in a data processing system for suggesting item replenishment, comprising:

determining that a purchasing entity is using an item;

establishing a condition for suggesting replenishment of the item;

testing the condition;

when testing indicates that the condition is satisfied, raising an event; and

when the event is raised, unilaterally suggesting replenishment of the item to the purchasing entity.

Claim 41 recites statutory subject matter under 35 U.S.C. § 101 based on the analysis provided by the January 2009 Memo and the *Bilski* decision. This claim recites a physical and tangible object, specifically, an item. Information corresponding to this item, which is a condition for suggesting replenishment of the item, provides a transformation that triggers an action. This action includes testing whether the condition corresponding to the item is met. If the condition is satisfied, a further transformation occurs of raising an event that suggests replenishing that item to the purchasing entity. Accordingly, this claim is patent-eligible under the second prong of *Bilski*'s machine-or-transformation test. Hence, it is respectfully requested that the Board reverse the rejection of claim 41.

Further, claims 42-43 and 45-47, which depend from claim 41, also recite statutory subject matter for at least the same reasons as claim 41. Therefore, it is respectfully requested that the Board reverse the rejection of these claims.

B. Claims 36 and 37 Recite Statutory Subject Matter

The Examiner rejected claims 36 and 37 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The rejection is improper because the claims recite statutory subject matter. Specifically, the independent claim 36 recites:

A computer memory containing an item replenishment data structure, the data structure comprising a plurality of entries, each entry comprising an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed, such that, on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry. (Emphasis added).

A computer memory is a specific article of manufacture within a computer system.

Articles of manufacture are one of the four classes of statutory subject matter. (See MPEP 2106). Here, the claim explicitly recites an article of manufacture that is a computer memory. Moreover, the MPEP also states that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” (MPEP 2106.01). Here, the computer readable medium, a memory in claim 36 (*see specification, p. 5, ll. 11-19*), further recites a data structure and structural and functional interrelationships such that this claim recites statutory subject matter. Accordingly, for at least the reasons set forth above, claim 36 recites statutory subject matter and

is patent-eligible.

Likewise, claim 37 depends from claim 36 and also recites statutory subject matter for at least the same reasons as claim 36. Hence, it is respectfully requested that the Board reverse the rejection of claims 36 and 37.

C. Rejection of Claim 38 Is Moot

The Examiner rejected claim 38 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The rejection is now moot in view of the Amendment filed under 37 C.F.R. § 41.33 on December 10, 2007, which cancelled claim 38.

D. Claims 1-16 and 36-44 Are Not Obvious in View of Kenney and Ono

1. The Rejection of the Claims is an Improper Omnibus Rejection

Appellants begin by noting that in rejecting the claims in the second Supplemental Examiner's Answer the Examiner did not explain the pertinence of the references to the specific claims being rejected thereunder. The rejection amounted to no more than an omnibus rejection. As stated in the MPEP, “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” (Emphasis added) (MPEP 707.07(d)). Here, the Examiner did not specifically point out how the cited references applied to each distinct claim and the elements recited therein. Accordingly, the Board is respectfully requested to reverse the rejection of these claims. Nevertheless, to further the appeal process, the Appellant also responds to the Examiner's allegations below.

2. Kenney Does Not Provide a Consumer with an Indication that a Product Should Be Replenished

On page 6 of the second Supplemental Examiner's Answer, the Examiner rejects claims 1-26 and 36-44 under 35 U.S.C. § 103(a) as being unpatentable over Kenney and Ono.

Thereafter, without reference to any specific claim and elements, the Examiner on page 7 of the second Supplemental Examiner's Answer asserts:

The user is provided with an indication that the product should be replenished (see Figs 5 and 7, col. 12 line 50+, it is displayed which products need to be reordered). The consumer then requests replenishment of the product by performing an interaction (clicking on the displayed product, col. 12 line 56) and the product is ordered (see Fig. 10A).

Appellant respectfully disagrees with this characterization of Kenney. Although the Examiner makes no mention of a specific claim or feature with respect to this assertion, Appellants note that Kenney fails to disclose “providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action” as recited in claim 1 (or similarly claim 15). Kenney discloses a reorder list 30 (Figure 5) and distinctive display of items on a shopper’s reorder list (Figure 7), but such disclosure is merely a list of items generated by a shopper. The Examiner’s interpretation that this is what is claimed is not supported by Kenney. (Second Supplemental Examiner’s Answer, p. 11).

Specifically, with respect to FIG. 7 of Kenney the description merely notes that:

The present invention also allows for rotational orientation so that if the shopper is in an aisle, looking in a particular direction, the computer 20 displays that view. . . Thus, as the shopper travels down the aisle from the end shown in FIG. 4, different data is retrieved from the computer 18 (or from data previously downloaded to the computer 20) to show movement along the aisle as indicated by the scene in FIG. 7. Also shown in FIG. 7 is one technique for identifying to the shopper items to be reordered and on special. Means other than the textual indicators of FIG. 7 can be

used; for example, the products can be made to flash or can be highlighted in a predetermined color.

An item to be reordered is only highlighted for a user to see where it is located in an aisle.

This clearly does not correspond to an “indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action” as is claimed. Moreover, there is nothing within Kenney to even suggest such control. To further illustrate this, Kenney discloses:

To make a reorder list, the shopper enters the current date, the item to be reordered and information regarding the reorder frequency, and stores the reorder list in memory in either the computer 20 or the computer 18. The list can be printed, and the shopper can then “go shopping” or end the session as desired. An example of a resultant output based on this type of list is shown in FIG. 5 by list 30, which shows items to be reordered as of the current date.

(Emphasis added)

(Kenney, col. 11, ll.20-28). The passage describes how the configuration disclosed in Kenney merely populates a list designated as a “reorder list” and thereafter makes such list available for printing or is stored. This is simply a conventional technique that does not disclose an “indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action” as is claimed. Hence, Kenney does not disclose this claimed feature.

Nor does Ono remedy the deficiencies of Kenney as has been set forth in prior briefings. For example, once it is determined that product or good is to be replenished, a user must go through a multistep process to order it. Specifically, Ono notes:

The client 220 displays on the output unit 223 an order information confirmation screen 1300 such as that shown in FIG. 13. The order information confirmation screen 1300 has an ordered good display area 1301, a settlement input area 1303, an OK button

1304, and a cancel button 1305. Step 305: Input of payment type and confirmation will. Observing the order information confirmation screen 1300, the user of the client 220 enters a payment type and a confirmation will from the input unit 222. One of the payment types, including card payment, bank transfer, collect on delivery, and the like is selected from the payment type area 1303 and a confirmation will is entered by using the OK button 1304.

(Ono, col. 7, col. 12-25; Fig. 13). This multi-action process actually teaches away from the claimed recitation of replenishment of a product by performing a single action through a control. Accordingly, there is no disclosure in Ono of “providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action,” as is claimed.

Thus, for at least the reasons set forth above, the combination of Kenney and Ono fails to disclose at least the claimed feature of “. . . providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action.” Accordingly, the Board should reverse the rejection of the claims 1 and 15 and their respective dependencies.

3. Ono Fails to Disclose, Teach or Suggest Transmitting Information of a Product Whose Purchase Interval has Lapsed on or Before the Target Date or Determining a Target Date for Suggesting Replenishment of a Product

On pages 7 and 8 of the second Supplemental Examiner’s Answer, the Examiner states:

Ono discloses a purchase history information of each good purchased by a user that is stored at a service offering system (abstract, Fig. 5) and in response to an input of identification information from a service use system [sic], the system offering system searches the purchases history information of the user corresponding to a user identifier and calculates a purchase interval of each good purchase by a user (102, Fig. 1), the service offering system judges, for each good whose purchase interval was calculated, whether a product purchase interval has lapsed after the

latest purchase day (103, Fig. 1) and the service offering system transmits information of a good whose time corresponded to the purchase interval has lapsed to the service via a communication network and displaying the information at the service use system (abstract, 104, 223, Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Kenney to transmit information of the good whose purchase interval has lapsed or to provide an indication to the consumer on or before the target date, as taught by Ono, so the consumer will not run out of the item because it would estimate a demand occurrence time for each good and supply a user with the merchandise information at the estimated time of the next purchase.

Appellant respectfully disagrees with this characterization of Ono's disclosure. Although the Examiner again makes no specific mention of a specific claim or feature, Appellants point to claim 1 (and similarly claim 15) as disclosing "before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action."

Ono describes providing information regarding a product whose purchase interval has lapsed. Specifically, Ono states:

The server 210 searches the purchase history information of the user corresponding to the user identifier from purchase history information 500 stored in the storage device 212 in the form of database or file. In accordance with the searched purchase history information, purchase intervals of merchandise the user purchased in the past are calculated (Step 102). Next, the server 210 judges, for each product or good whose purchase interval was calculated, whether the time corresponding to the purchase interval calculated at Step 102 has lapsed after the latest purchase day (Step 103). The server 210 then transmits information of each good whose time corresponding to the purchase interval has lapsed, via the communication network 230 to the client 220 to display it on the output unit 223 (Step 104). (Emphasis added).

(Ono, col. 4, ll. 34-49). The fact that Ono is concerned only about lapsed time is further

confirmed by the passages cited by the Examiner:

Step 103: Judgement [sic] of lapse of purchase interval. The server 210 judges for all products or goods whose purchase intervals were calculated at Step 102 whether the time corresponding to the purchase interval has lapsed. (Emphasis added).

(Ono, col. 7, ll. 8-11). Even considering the Examiner's interpretation on page 11 of the second Supplemental Examiner's Answer, the present claims do not contemplate that such interval has lapsed; rather, the claims provide for taking an action prior to a particular date lapsing. This is what clearly distinguishes what is claimed from what Ono discloses. Ono contains no indication of providing of a replenishment configuration "before the second date as is claimed."

Likewise, as the Examiner correctly notes, Kenney does not disclose lapsed dates or taking action before a second date. Hence, not only does this combination of these references not disclose "providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action," as is claimed, the combination also does not disclose "before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action." Accordingly, the Board should reverse the rejection of claims 1 and 15 and their respective dependencies.

4. The Combination of Kenney and Ono Fails to Teach Determining a Target Date Based on Availability of an Item, Size of an Item, or Expiration Date of an Item and also is Not Obvious in view of these References

On pages 8 and 9 of the second Supplemental Examiner's Answer, the Examiner states:

Neither Kenney nor Ono teaches the step of determining a target date based on availability of an item. However, it is common in the

art to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available. Neither Kenney nor Ono teaches the step of determining a target date based on the size of the item. However, it is commonly known in the art that the size of an item will impact the length of time it takes to consume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a target date based on the size of the item, so that a more accurate date is determined. Neither Kenney nor Ono teaches the step of determining a target date base on an expiration date. However, it is commonly known in the art that items need to be replaced after they expire. It would have been obvious to one of ordinary skill in the [art] at the time the invention was made to employ to determine a target date based on an expiration date so that a customer will replace expired items.

It appears that the Examiner is attempting to take Official Notice of elements not found in any applied reference. The MPEP makes it clear that “official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” (MPEP 2144.03). Such is not the case with respect to the claims as recited.

As with the other new grounds for rejection, the Examiner once again fails to address specific claims in asserting this rejection. Assuming reference is made to claim 2 (and similarly claim 15), which recites the following:

A method in a data processing system for ordering an item, comprising:
on a first date, fulfilling an order by a consumer for a first item;
determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item;

on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item;

receiving an indication that the control was used by the consumer to request replenishment of the first item; and

in response solely to receiving the indication, ordering a second item to replenish the first item.

Here, the claimed configuration first fulfills an order for a first item on a first date and then determines a target date for suggesting replenishment of the first item based on a first date and an identity of the first item so that on the target date a customer is provided with an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item. In this context, there was nothing, at the time of filing, that was common knowledge or well-known in the art to use a target date as claimed to thereafter provide an indication and control structure that would allow for effectuating replenishing of that item. This is, of course, further illustrated by the lack of citation to any prior art reference that would either disclose, suggest, or teach such a claimed feature. Accordingly, the Board is respectfully requested to reverse the rejection of claims 2 and 15 along with their respective dependencies.

The reasoning set forth above also applies to claims 27 and 31 (“determining that a purchasing entity possesses an item; determining an expiration time for the item; and scheduling for a time preceding the determined expiration time”) and claims 12 and 25 (“target date is determined based on the size of the first item”). Accordingly, the Board is respectfully requested to reverse the rejection of claims 12, 25, 27, and 31.

D. Claims 27-35 and 45-47 Not Obvious in View of Kenney, Ono, and Hirst

1. Nowhere Does Hirst Teach or Suggest Scheduling for a Time Preceding the Expiration Time a Unilateral Transmission of a Communication to the Purchasing Entity Indicating that the Item Should be Replenished

On pages 9 and 10 of the second Supplemental Examiner's Answer, the Examiner rejects claims 27-35 and 45-47 under 35 U.S.C. § 103(a) in view of Kenney, Ono and Hirst.

Specifically, it is alleged that:

Hirst discloses a processor (38) providing a signal to controls and displays to indicate a warning message reminder (128, 130, Fig. 6) to schedule a reordering process for a particular product and sometimes the reordering is done automatically as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the message indication and the automating reordering, as taught by Hirst, in the combined system of Kenney in view of Ono because it would ensure that customers are aware of an upcoming event and that products are ordered in a timely fashion.

Appellant respectfully disagrees. Claim 27 recites, *inter alia*, “determining an expiration time for the item” and based on this determination of expiration, “scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.”

Hirst describes monitoring the consumption of a printing supply, such as toner, in a printer. (Hirst, col. 5, ll. 1-40). Although Hirst describes providing a warning message to indicate a low toner condition, it only provides a warning signal of such condition. It does not disclose “scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.” Hirst merely provides a conventional warning that consumption of toner surpassed a certain limit, which is not what is claimed.

Kenney and Ono do not remedy these deficiencies of Hirst. Moreover, Hirst also fails to disclose the deficiencies noted above with respect to Kenney and Ono. Nevertheless, even assuming, *arguendo*, that the references could be combined, the combination still fails to disclose the claimed invention. At best such combination merely provides that when a particular time has lapsed (Ono), an electronic list is updated with information (Kenney) that an order has surpassed a certain limit (Hirst). This combination still fails disclosure of “determining an expiration time for the item” and based on this determination of expiration “scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished” as claimed. Accordingly, a *prima facie* case has not been established by the Examiner and the Board is respectfully requested to reverse the rejection.

2. The Examiner has Failed to Identify a Sufficient Reason for Combining Kenney, Ono, and/or Hirst

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

The Supreme Court decision in *KSR Int'l v. Teleflex, Inc.*, 550 U.S. 398, (slip op., U.S. Apr. 30, 2007) reaffirmed the holdings of Graham, and clarified several aspects of the manner in

which obviousness should be determined. (*KSR*, slip op. at 11). In particular, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,” rather, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” (*KSR*, slip op. at 14-15). The Court recognizes that many significant advances will combine familiar elements: “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (*KSR*, slip op. at 15).

Following the decision in *KSR*, the USPTO issued a memorandum to all Examiners. The memorandum directs Examiners to continue to determine why a person of ordinary skill in the art would make the combination, “in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” (*KSR*, slip op. at 2).

Under these standards, Appellant’s claimed invention would not have been obvious because the Examiner has not identified prior art references, or a combination thereof, that disclose all the elements of the pending claims as described above and in prior briefings. Moreover, the Examiner has failed to identify a sufficient reason for combining the cited prior art references.

To present a *prima facie* case of obviousness, the Examiner must show that “there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”

(KSR, slip op. at 14). The Examiner's analysis "should be made explicit." (*Id.*). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))).

On page 8 of the second Supplemental Examiner's Answer, the Examiner again states the following as the reason to combine Kenney and Ono:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Kenney to transmit information of the good whose purchase interval has lapsed or to provide an indication to the consumer on or before the target date, as taught by Ono, so the consumer will not run out of the item because it would estimate a demand occurrence time for each good and supply a user with the merchandise information at the estimated time of the next purchase. (Emphasis added.)

Appellant respectfully disagrees. As discussed above, Ono fails to teach or suggest transmitting information of a good whose purchase interval has lapsed on or before the target date or determining a target date for suggesting replenishment of an item. As noted in the previous papers, Ono requires that the user start an online shopping session before Ono judges whether the purchase interval has lapsed for any product identified in the user's purchase history. (Ono, col. 4, ll. 28-57; Kenney, col. 6, ll. 41-43, col. 11, ll. 20-34). Thus, Ono does not transmit information of a product having a lapsed purchase interval so that the consumer does not run out of the product, as suggested by the Examiner. Rather, consistent with Ono's stated purpose of reducing the number of products the user forgets to purchase during a shopping session (Ono, col. 4, ll. 56-57), Ono identifies products whose purchase interval has lapsed only during the shopping session. Moreover, the reason provided by the Examiner appears to be based solely on the alleged beneficial results that would be produced by combining the references, without

identifying any reason other than the Examiner's conclusory statements that supports the proposed combination. Such an approach is impermissible hindsight based on the teachings gleaned only from Appellant's application. (*See* MPEP 2145).

In addition, on page 8 of the second Supplemental Examiner's Answer, the Examiner again states the following as the reason to combine Kenney and Ono:

However, it is common in the art to only suggest the purchase of an item if that item is in stock. It therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to use the availability of the item to determine a target date so that the indication is sent only if the item is available.

Appellant disagrees with this conclusion for which no support is provided. In fact, at best what is common in the art is that only after an order is placed for an item is a determination made whether such item is in stock. Again, the reason provided by the Examiner appears to be based solely on the alleged beneficial results that would be produced by combining the references, without identifying any reason other than the Examiner's conclusory statements that supports the proposed combination. Such an approach is impermissible hindsight based on teachings of Appellant's application. (*See* MPEP 2145).

Further, on page 10 of the second Supplemental Examiner's Answer, the Examiner states the following as the reason to combine Kenney, Ono, and Hirst:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the message indication and the automated reordering, as taught by Hirst, in the combined system of Kenney in view of Ono because it would ensure that customers are aware of an upcoming event and that products are ordered in a timely fashion.

Again, Appellant respectfully disagrees. As discussed above, Hirst fails to teach or

suggest scheduling the warning message at a time preceding a determined expiration time of the printing supply. Moreover, there would be no reason to combine Hirst with either Kenney or Ono. Hirst monitors a printer's toner consumption and reports a low toner condition only when the consumption of toner surpasses a specified limit. Because neither Kenney nor Ono monitor the consumption of products purchased by a shopper, Hirst's reporting technique would serve no practical purpose. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Board is respectfully requested to reverse the rejection of the claims.

SUMMARY

For at least the reasons provided above, along with the reasons presented in Appellant's Appeal Brief and prior Reply Brief each of claims 1-37 and 39-47 has been improperly rejected. Accordingly, Appellant seeks reversal of the rejection of these claims.

Respectfully submitted,
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Dated: February 5, 2009 By: _____ /Rajiv P. Patel/

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CLAIMS APPENDIX

1. (Previously presented) A method in a data processing system for automatically initiating the replenishment of a consumable product, comprising:
 - on a first date, fulfilling an order by a consumer for a first instance of the product;
 - based upon the first date, estimating a second date by which the first instance of the product will be fully consumed;
 - before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action;
 - receiving an indication that the control was used by the consumer to request replenishment of the product; and
 - in response solely to receiving the indication, ordering a second instance of the product to replenish the first instance.
2. (Previously presented) A method in a data processing system for ordering an item, comprising:
 - on a first date, fulfilling an order by a consumer for a first item;
 - determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item;
 - on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the

consumer to request replenishment of the first item;
receiving an indication that the control was used by the consumer to request
replenishment of the first item; and
in response solely to receiving the indication, ordering a second item to replenish the first
item.

3. (Previously presented) The method of claim 2 wherein the control is usable by the consumer to request replenishment of the first item by performing a single action.
4. (Original) The method of claim 2 wherein the second item is a physical article.
5. (Original) The method of claim 2 wherein the second item is a data product.
6. (Original) The method of claim 2 wherein the second item is a service.
7. (Original) The method of claim 2 wherein the target date is determined based on an average life span of the first item.
8. (Original) The method of claim 2 wherein the target date is determined based on an expiration date for the first item.
9. (Original) The method of claim 2 wherein the target date is determined based on an availability date for the second item.
10. (Original) The method of claim 2 wherein the target date is determined based on the length of the intervals between the prior purchases.

11. (Original) The method of claim 2 wherein the consumer has made a plurality of prior purchases of a complement of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.

12. (Original) The method of claim 2 wherein a target date is determined based on the size of the first item.

13. (Original) The method of claim 2 wherein the target date is determined based on information provided by the consumer.

14. (Original) The method of claim 2 wherein a target date is determined based on information about the consumer's lifestyle.

15. (Previously presented) A computer-readable medium whose contents cause a computer system to order an item by:

receiving an indication of an order by a consumer for a first item having a first date;

determining a target date based upon the identity of the first item;

on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item;

receiving an indication that the control was used by the consumer to request replenishment of the first item; and

in response solely to receiving the indication, ordering a second item to replenish the first item.

16. (Original) The computer-readable medium of claim 15 wherein the provided indication includes a control usable by the consumer to request replenishment of the first item, the method further comprising:

receiving an indication that the control was used by the consumer to request replenishment of the first item; and

in response to receiving the indication, ordering a second item to replenish the first item.

17. (Previously presented) The computer-readable medium of claim 16 wherein the control is usable by the consumer to request replenishment of the first item by performing a single action.

18. (Original) The computer-readable medium of claim 15 wherein the first date is a date on which the order for the first item was placed.

19. (Original) The computer-readable medium of claim 15 wherein the first date is a date on which the order for the first item was fulfilled.

20. (Original) The computer-readable medium of claim 15 wherein the target date is determined based on an average life span of the first item.

21. (Original) The computer-readable medium of claim 15 wherein the target date is determined based on an expiration date for the first item.

22. (Original) The computer-readable medium of claim 15 wherein the target date is determined based on an availability date for the second item.

23. (Original) The computer-readable medium of claim 15 wherein the consumer has made a plurality of prior purchases of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.

24. (Original) The computer-readable medium of claim 15 wherein the consumer has made a plurality of prior purchases of a complement of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.

25. (Original) The computer-readable medium of claim 15 wherein a target date is determined based on the size of the first item.

26. (Original) The computer-readable medium of claim 15 wherein the target date is determined based on information provided by the consumer.

27. (Previously Presented) A method in a data processing system for assessing item replenishment, comprising:

determining that a purchasing entity possesses an item;

determining an expiration time for the item; and

scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.

28. (Original) The method of claim 27, further comprising delivering the communication at the scheduled time.

29. (Original) The method of claim 28 wherein the delivered communication contains a control for ordering an additional item to replenish the item.

30. (Original) The method of claim 29, further comprising:
receiving an indication that the purchasing entity used the control contained in the delivered communication to order an additional item to replenish the item; and

in response to receiving the indication, ordering an additional item to replenish the item.

31. (Previously Presented) A computer-readable medium whose contents cause a data processing system to assess item replenishment by:

determining that a purchasing entity is using an item;
determining an expiration time for the item; and
scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.

32. (Original) The computer-readable medium of claim 31, further comprising delivering the communication at the scheduled time.

33. (Original) The computer-readable medium of claim 32 wherein the delivered communication contains a control for ordering an additional item to replenish the item.

34. (Original) The computer-readable medium of claim 33, further comprising:
receiving an indication that the purchasing entity used the control contained in the

delivered communication to order an additional item to replenish the item; and
in response to receiving the indication, ordering an additional item to replenish the item.

35. (Previously presented) A system for automatic item replenishment, comprising:
a replenishment targeting subsystem that, for a particular item purchased by a purchaser
on a purchased date, determines a target date for replenishment of the item;
a replenishment proposal subsystem that transmits to the purchaser in advance of the
target date determined for the item by the replenishment targeting subsystem, at a
time at which the purchaser is not engaged in an electronic shopping activity, a
replenishment proposal to order a replacement for the item; and
a replenishment ordering subsystem that orders a replacement for the item responsive to
an affirmative response to the replenishment proposal from the purchaser.

36. (Previously presented) A computer memory containing an item replenishment
data structure, the data structure comprising a plurality of entries, each entry comprising an
identification of a consumer, an identification of an item, and an indication of a target date on
which the replenishment of the item is to be proposed, such that, on a current date, for each entry
indicating the current date as its target date, a unilateral communication can be transmitted to the
consumer identified by the entry proposing the replenishment of the item identified by the entry.

37. (Original) The computer memory of claim 36 wherein the item replenishment
data structure further comprises, for each of a plurality of dates, an indication of the entries
indicating the date as their target date.

38. (Canceled).

39. (Original) A method in a computer system for automatically replenishing an item, comprising

determining that a consumer is using an item;

determining a target date for replenishing the item; and

without intervention by the consumer, placing an order on the consumer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date.

40. (Original) The method of claim 39 wherein the consumer has made a plurality of prior purchases of the item, and wherein the target replenishment date is determined based on the length of the intervals between the prior purchases.

41. (Previously presented) A method in a data processing system for suggesting item replenishment, comprising:

determining that a purchasing entity is using an item;

establishing a condition for suggesting replenishment of the item;

testing the condition;

when testing indicates that the condition is satisfied, raising an event; and

when the event is raised, unilaterally suggesting replenishment of the item to the purchasing entity.

42. (Original) The method of claim 41 wherein the established condition is a temporal condition.

43. (Original) The method of claim 41 wherein the established condition is the availability of a replacement item.

44. (Previously presented) The method of claim 1 wherein the control contained in the received indication includes a defined region in which the user may perform a single mouse click in order to request replenishment of the product.

45. (Previously presented) The system of claim 35, further comprising an electronic mail transmission subsystem that transmits replenishment proposals as electronic mail messages on behalf of the replenishment proposal subsystem.

46. (Previously presented) The system of claim 35, further comprising an instant message transmission subsystem that transmits replenishment proposals as instant messages on behalf of the replenishment proposal subsystem.

47. (Previously presented) The system of claim 35, further comprising a voicemail transmission subsystem that transmits replenishment proposals as voicemail messages on behalf of the replenishment proposal subsystem.